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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,303	03/09/2004	Gary Weller	514362001410	4452
John S. Nagy 7590 06/28/2007 (Fulwider, Patton, Lee & Utecht, LLP) Howard Hughes Center 6060 Center Drive, Tenth Floor Los Angeles, CA 90045				
EXAMINER YABUT, DIANE D				
ART UNIT 3734		PAPER NUMBER		
MAIL DATE 06/28/2007		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/797,303

Applicant(s)

WELLER ET AL.

Examiner

Diane Yabut

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/12/2007

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to applicant's amendment received 1 March 2007.

#### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 1 March 2007 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Objections***

2. Claims 18-19 and 27-28 are objected to because of the following informalities: the claims recite "bioabsorbable" and should rather be --bioabsorbable--. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 recites the limitations "the elongate body" and "the acquisition apparatus" in lines 1-2. There is insufficient antecedent basis for these limitations in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-15, 20-24, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by **Deem** (U.S. Pat. No. **6,558,400**).

Claims 1-12, 21 and 26: Deem discloses a rectangular or arcuate distal working portion having a longitudinal axis, a perimeter, and an inner volume or vacuum chamber adapted to adhere tissue thereto, the working portion comprising a first acquisition member and a second acquisition member in apposition to one another along a first longitudinal axis, having an elongate body parallel and attachable to the acquisition apparatus, wherein each of the acquisition members are adapted to adhere tissue thereto such that the tissue is positioned between the first and second acquisition

members or within the inner volume and about the perimeter of the distal working portion to define a gastric pouch, and at least one of the acquisition members being movable relative to the first longitudinal axis between a delivery configuration and a deployment configuration, the device also comprising a septum removable positioned between the first and second acquisition members (Figures 9A-11B, col. 10, lines 39-65, col. 11, line 3 to col. 12, line 33).

Claims 13-15 and 22-24: Deem discloses an expandable element **52** being selected from the group consisting of a scope, a balloon, and a wire form, and the device being adapted for use with an endoscope (Figures 3A-3C and 17A, col. 8, lines 31-39, col. 15, lines 40-44).

Claim 20: Deem discloses the tissue acquisition member comprising a cartridge assembly containing at least one fastener **160** therein for affixing to tissue (Figures 8A-8B).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16, 18-19, 25, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deem (U.S. Pat. No. **6,558,400**).

Claims 16 and 25: Deem discloses the claimed device except for the device comprising a transducer. However, Deem does disclose a vacuum (see paragraph 6 above) and it was well known in the art to use a transducer with a vacuum in order to tell the pressure at the anvil portion prior to stapling the tissue, and therefore it would have been obvious to one of ordinary skill.

Claims 18-19 and 27-28: Deem discloses the claimed device except for the septum being made of a bioabsorbable material selected from the group consisting of polylactic acid (PLA), poly(lactic-co-glycolic acid) (PLGA), and polyglycolic acid (PGA). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a septum made of bioabsorbable

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Deem** (U.S. Pat. No. **6,558,400**), as applied to Claim 11 above, and further in view of **Schurr** (U.S. Pub. No. **20020082621**).

Claim 17: Deem discloses the claimed device except for the tissue acquisition member being pivotally movable relative to the septum.

Schurr teaches a tissue acquisition member **200** being pivotally movable relative to a septum **110** (Figures 4-5). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a pivotable tissue acquisition member, as taught by Schurr, to Deem since it was known in the art that pivotable tissue acquisition members facilitates grasping and apposition of tissue to ensure a secure engagement of the tissue(s).

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER